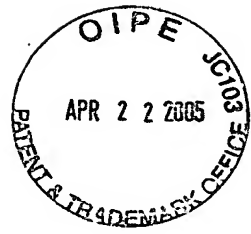


Application No. 10/721,131

Election Pursuant to Requirement for Restriction dated
March 25, 2005

IFW



Appl. No. :10/721,131 Confirmation No.: 6353
Applicant(s) :H.S. Kolesinski et al.
Filed :November 25, 2003
Title :CHROMATOGRAPHIC SEPARATION
PROCESSES AND APPARATUS
TC/A.U. :1723
Examiner :Ernest G. Therkorn

Docket No. :HK001AFP

Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

ELECTION PURSUANT TO REQUIREMENT FOR RESTRICTION

Sir:

This paper is in response to the Office Action
mailed March 25, 2005 in the above-identified application
for Letters Patent.

1. The examiner has made a requirement for
restriction under 35 U.S.C § 121 between two groups of
claims as follows:

I. Claims 1-3, 5, 8-10, 21 and 22
drawn to a separation apparatus, classified in class 210,
subclass 198.2; and

II. Claims 11-14, 16, 19 and 20 drawn to
a chromatographic separation process, classified in class
210, subclass 656.

In support of the requirement, the examiner has

Application No. 10/721,131
Election Pursuant to Requirement for Restriction dated
March 25, 2005

stated that the two groups of claims define inventions which are related as process and apparatus for its practice and, further, that the apparatus, as claimed could be used to practice a materially different process than that which is claimed. The examiner has concluded that since the inventions are distinct and have acquired a separate status in the art as shown by their different classifications, restriction for the purposes of examination is proper.

Applicants request reconsideration of this requirement. Whether to require restriction between respective groups of claims in a patent application is discretionary with the United States Patent and Trademark Office. Here, the separation apparatus disclosed and claimed in the present application is taught for use in the specific separation process which is disclosed and claimed. Thus, the claimed subject matter recited in each of the respective groups of claims is closely related to that of the other group of claims. The two groups are so closely related as to form a single inventive concept and can be examined conveniently in one application with one search.

The chromatographic separation process recited in independent claim 11 recites the step of "...passing a fluid containing a mixture of different components through a chromatographic apparatus as defined in claim 1...". Thus, it would appear that in order to properly examine the separation process of claim 1 it would be

Application No. 10/721,131
Election Pursuant to Requirement for Restriction dated
March 25, 2005

necessary to search the subclass in which the process is classified and the subclass in which the apparatus is classified. It is noted that both groups of claims are classified in the same class, albeit in different subclasses. Both groups of claims could conveniently be examined with one search without any undue burden being imposed on the USPTO.

In support of the requirement the examiner has stated

In this case, the apparatus as claimed could be used to practice another and materially different process. For example, the apparatus could be used as a chemical or biochemical reactor in a chemical or biochemical reaction process.

This rationale for the restriction requirement should not be given controlling importance in view of the relationship of the subject matter recited in the two groups of claims as pointed out above.

Under these circumstances, and particularly since, as has been pointed out above, examining all the claims in this application would not impose any undue burden on the USPTO, the sound exercise of discretion should dictate that all the claims in the application be examined in the present application. To do so would be beneficial to the USPTO, applicants and the general public.

For the foregoing reasons, applicants request that the requirement for restriction be withdrawn and all the claims examined in this application.

Application No. 10/721,131
Election Pursuant to Requirement for Restriction dated
March 25, 2005

2. Nevertheless, should the examiner adhere to the requirement, in accordance with 37 C.F.R. § 143 applicants hereby provisionally elect the claims of Group II (11-14, 16, 19 and 20) for examination in the present application without prejudice to their rights under 35 U.S.C. §121 and 37 C.F.R. § 1.144.

Respectfully submitted,



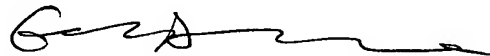
Gaetano D. Maccarone
Registration No. 25, 173

63 Chelsea Street
Cambridge, MA 02129
Tel.: 617-337-1818

CERTIFICATE OF MAILING

I hereby certify that this paper (along with any paper referred to as being attached or enclosed) is being deposited with the United States Postal Service on the date shown below with sufficient postage as first class mail in an envelope addressed to Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Date: April 19, 2005



Gaetano D. Maccarone
Registration No. 25,173